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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,081

03/12/2004

Saburou Abe

3216/1

8512

23638

7590

03/15/2006

ADAMS EVANS P.A.  
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EXAMINER

HARDEE, JOHN R

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/799,081

Applicant(s)

ABE ET AL.

Examiner

John R. Hardee

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5-7,9,12,16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,10,11,13-15 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Solvent Blue 63 and a composition comprising this dye, ethylene glycol and water in the reply filed on February 16, 2006 is acknowledged. The traversal is on the ground(s) that the examiner has not stated why the dyes are patentably distinct, and because the examiner has not demonstrated any burden of search. This is not found persuasive because the burden is self evident in view of the vast number of dyes, recited and unrecited, that the claims read on. Regarding reasons why the dyes are patentably distinct, in the absence of any reference which indicates that *all* dyes may be substituted for each other in the formulation of a coolant composition, there appears to be no motivation to do so. However, if applicant would like to state on record that this is the case, the examiner will reconsider the election requirement.

The requirement is still deemed proper and is therefore made FINAL.

2. As applicant's elected composition was found to be obvious, the dyes were not further searched or examined. Claims 5-7, 9, 12, 16 and 17 are withdrawn from consideration by the examiner as being drawn to embodiments non-elected with traverse.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 8, 10, 11, 13-15 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are drawn to a coolant composition which is to be blended into a coolant. The examiner understands all of the limitations except the presence of the base material and the dye to be recitations of intended use which are not afforded patentable weight. Furthermore, it would appear that the conductivity of the coolant, when made, will be as dependent on the amount of coolant, the amount of base material, the identity of the coolant, the identity of the base material and the amount of dye as it is on the identity of the dye. Applicant's claim language appears to be putting implicit limitations on all of these things while only claiming an unnamed base material, in no particular amount, and a dye, again in no particular amount. Claims 2 and 3 recite further intended use and appear to put implicit limitations on the ionic nature of the dye. *These are exemplary. All of the claims should be carefully examined for problematical language of this sort.*

In claim 3, is the second instance of "or" stricken out? If not, it should be.

In claim 13, is applicant claiming a composition which is about 50% dye? If not, what else is present?

#### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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6. Claims 1-4, 8, 10, 11, 13-15 and 18-20, to the extent that they read on the elected composition, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al., US 2002/0144356. The reference discloses hair dyeing compositions. Suitable dyes include Solvent Blue 63 [0017]. The dye may be present at as little as 0.005%. Suitable solvents include ethylene glycol [0029]. The solvent is present at 0.1-50% by weight [0030]. The exemplified compositions are approximately 80% water and, when used, are diluted 1:10 with water. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a colorant composition. The person of ordinary skill in the art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

The art is apposite because it is drawn to the problem of making colored solutions.

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7. The rejections over Bruhnke are withdrawn because the reference does not disclose or motivate the formulation of applicant's elected composition.

8. Applicant's affidavit has been carefully considered, but it is not persuasive. In fact, it supports the examiner's position. Applicant has demonstrated that compositions comprising 0.01% of various ionic dyes provide an eventual conductivity, when a coolant is made to an arbitrary formulation, that is greater than what is claimed. However, if the dyes were present at the low end of applicant's claimed concentration range, three orders of magnitude more dilute, they would clearly meet the recited conductivity limitations. In fact, it appears that the conductivity limitations would be met if half as much ionic dye were present. The examples are not commensurate in scope with applicant's claimed limitations--in the few instances where limitations are recited.

9. This action contains grounds of rejection which were not motivated by applicant's amendments. Accordingly, it is NOT FINAL.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Mr. Douglas McGinty, may be reached at (571) 272-1029.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Hardee", with a stylized flourish at the end.

John R. Hardee  
Primary Examiner  
March 13, 2006